

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte IGOR ALEXEFF

Appeal No. 2001-1344
Application No. 09/218,763

ON BRIEF

Before RUGGIERO, DIXON, and GROSS, Administrative Patent Judges.
RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal from the final rejection of claims 1, 2, 4-9, 11, 13-19, and 21-24, which are all of the claims pending in the present application. Claim 3, 10, 12, and 20 have been canceled.

The claimed invention relates to an image viewing device having a member with an aperture that permits light rays from the image to enter through the aperture. Further included is an

optical block of refractive material located adjacent to the aperture. According to Appellant (specification, page 5), the optical block compresses the entering light rays and produces an image representative of at least a 180 degree field of view.

Claim 1 is illustrative of the invention and reads as follows:

1. An image viewing device, comprising:

a member having an area defining an aperture, the light rays from the image entering through the aperture; and

an optical block comprised of a refractive material, the optical block being located adjacent to the aperture, the optical block being capable of compressing the light rays from the image that pass through the aperture so as to produce an image comprising at least a 180° field of view.

No prior art references are relied on by the Examiner.

Claims 11 and 19 stand finally rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the invention.

Claims 1, 2, 4-9, 11, 13-19, and 21-24, all of the appealed claims, stand finally rejected under 35 U.S.C. § 112, first paragraph, as being based on an inadequate disclosure.

Rather than reiterate the arguments of Appellant and the Examiner, reference is made to the Brief (revised, Paper No. 14) and Answer (Paper No. 15) for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the Examiner, the arguments in support of the rejections, and the evidence relied upon by the Examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, Appellant's arguments set forth in the Brief along with the Examiner's rationale in support of the rejections and arguments in rebuttal set forth in the Examiner's Answer.

It is our view, after consideration of the record before us, that the disclosure in this application describes the invention as set forth in claims 1, 2, 4-9, 11, 13-19, and 21-24, all of the appealed claims, in a manner which complies with the requirements of the first paragraph of 35 U.S.C. § 112. It is also our view that claim 11 particularly points out the invention in a manner which complies with 35 U.S.C. § 112, second paragraph. We reach the opposite conclusion with respect to the Examiner's indefiniteness rejection of claim 19. Accordingly, we affirm-in-part.

We consider first the Examiner's indefiniteness rejection of claims 11 and 19 under the second paragraph of 35 U.S.C. § 112. The general rule is that a claim must set out and circumscribe a

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particular area with a reasonable degree of precision and particularity when read in light of the disclosure as it would be by the artisan. In re Moore, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971). Acceptability of the claim language depends on whether one of ordinary skill in the art would understand what is claimed in light of the specification. Seattle Box Co. v. Industrial Crating & Packing, Inc., 731 F.2d 818, 826, 221 USPQ 568, 574 (Fed. Cir. 1984).

After reviewing the arguments of record, we are in agreement with Appellant (Brief, page 6) that no ambiguity or lack of clarity exists in the language of claim 11. We agree with Appellant that the "optical block" is not being recited again in claim 11, nor is it being optionally included or eliminated as asserted by the Examiner (Answer, page 6). In our view, the skilled artisan would recognize from the language of claim 11 and a review of Appellant's specification that the image viewing device structure of base claims 1 and 9 is simply being further limited by the addition of a recording means which functions to record images produced by any combination of the previously recited image viewing device elements.

In view of the above discussion, it is our opinion that the skilled artisan, having considered the specification in its

entirety, would have no difficulty ascertaining the scope of the invention recited in claim 11. Therefore, the rejection of claim 11 as being indefinite under the second paragraph of 35 U.S.C. § 112 is not sustained. We do, however, sustain the Examiner's 35 U.S.C. § 112, second paragraph, rejection of claim 19 as improperly setting forth a duplicate recitation of an optical block "...comprised of a refractive material," a limitation which appears in base claim 1.¹

Turning to a consideration of the Examiner's assertion of lack of enablement of Appellant's disclosure, we note that, in order to comply with the enablement provision of 35 U.S.C. § 112, first paragraph, the disclosure must adequately describe the claimed invention so that the artisan could practice it without undue experimentation. In re Scarbrough, 500 F.2d 560, 566, 182 USPQ 298, 305 (CCPA 1974); In re Brandstadter, 484 F.2d 1395, 1404, 179 USPQ 286, 293 (CCPA 1973); and In re Gay, 309 F.2d 769, 774, 135 USPQ 311, 316 (CCPA 1962). If the Examiner has a reasonable basis for questioning the sufficiency of the disclosure, the burden shifts to Appellant to come forward with evidence to rebut this challenge. In re Doyle, 482 F.2d 1385, 1392, 179 USPQ 227, 232

¹ Appellant (Brief, page 6) does not contest the Examiner's 35 U.S.C. § 112, second paragraph, rejection of claim 19.

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(CCPA 1973), cert. denied, 416 U.S. 935 (1974); In re Brown, 477 F.2d 946, 950, 177 USPQ 691, 694 (CCPA 1973); and In re Ghiron, 442 F.2d 985, 992, 169 USPQ 723, 728 (CCPA 1971). However, the burden is initially upon the Examiner to establish a reasonable basis for questioning the adequacy of the disclosure. In re Strahilevitz, 668 F.2d 1229, 1232, 212 USPQ 561, 563 (CCPA 1982); In re Angststadt, 537 F.2d 498, 504, 190 USPQ 214, 219 (CCPA 1976); and In re Armbruster, 512 F.2d 676, 677, 185 USPQ 152, 153 (CCPA 1975).

The Examiner has questioned the sufficiency of Appellant's disclosure in enabling one of ordinary skill to produce an image viewing device as claimed. In particular, the Examiner's analysis concludes (Answer, page 6) that "... the disclosed invention is incapable of producing 'an image comprising at least a 180° field of view' as claimed."

At the outset, we note that, with respect to the embodiments of Appellant's invention in which light rays from an image enter the image viewing device 40 directly through aperture 44, we find the Examiner's line of reasoning (Answer, pages 6-8) sufficient to establish a reasonable basis for challenging the sufficiency of Appellant's disclosure. In particular, we find convincing the Examiner's assertion (id., at 6) that Appellant's described image viewing device could not produce a field of view of 180° since, at

the very least, there is no description as to how light rays from objects at 180° would be able to pass through aperture 44.

After reviewing the Examiner's analysis of the embodiment illustrated in Appellant's Figure 10, however, which includes a lens 60 placed in front of aperture 44, we reach the opposite conclusion as to whether a reasonable basis exists for challenging the sufficiency of the disclosure with regard to the claimed invention. In discussing Appellant's Figure 10 embodiment, th

ENDFIELD

Examiner (Answer, page 7) reasons, and we do not necessarily disagree, that such structure is not capable of directing light to aperture 44 beyond 180° and up to 220° as is its intended design. We would point out, however, that the claimed invention does not require an image viewing device which produces a field of view image beyond 180° but, rather, only a device which produces a field of view image of at least 180°. With this in mind, we simply find no basis provided by the Examiner for concluding that light rays from an image directed through an aperture through the intermediary of an optical lens would not produce an image with a field of view of at least 180° as claimed.

In view of the above discussion, we find that the Examiner has not established a reasonable basis for challenging the sufficiency

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of the instant disclosure with respect to the invention set forth in the appealed claims. While some experimentation by artisans may be necessary in order to practice the invention, we find that such experimentation would not be undue. Accordingly, we will not sustain the rejection of claims 1, 2, 4-9, 11, 13-19, and 21-24 under the first paragraph of 35 U.S.C. § 112.

In summary, we have not sustained the Examiner's 35 U.S.C. § 112, first paragraph, rejection of claims 1, 2, 4-9, 11, 13-19, and 21-24. With respect to the Examiner's 35 U.S.C. § 112, second paragraph rejection of claims 11 and 19, we have not sustained the rejection of claim 11, but have sustained the rejection of claim 19. Therefore, the Examiner's decision rejecting claims 1, 2, 4-9, 11, 13-19, and 21-24 is affirmed-in-part.

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No time period for taking any subsequent action in connection
with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

JOSEPH F. RUGGIERO)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JOSEPH L. DIXON)	APPEALS
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